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In re Application of GAO et al :
U.S. Application No.: 10/533,208 :
PCT Application No.: PCT/US03/34207 :
Int. Filing Date: 28 October 2003 : DECISION
Priority Date Claimed: 28 October 2002 :
Attorney Docket No.: INV850/4-11US/55006 :
For: ARRAY OLIGOMER SYNTHESIS AND :
USE :
:

This is in response to applicant's "Petition Under CFR §1.47" filed 21 April 2006.

BACKGROUND

On 28 October 2003, applicant filed international application PCT/US03/34207, which claimed priority of an earlier United States application filed 28 October 2002. The thirty-month period for paying the basic national fee in the United States expired on 28 April 2005.

On 28 April 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 21 October 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 21 April 2006, applicant filed the present petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be

reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicant has submitted declarations signed by the available inventors each on his/her own behalf and on behalf of the nonsigning inventors.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

* * *

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

Inventor Qimin You

The petition adequately demonstrates that a bona fide attempt was made to present a copy of the application papers to inventor You for signature. In particular, the application papers were sent to inventor You via electronic mail on 02 March 2006. Furthermore, the petition sufficiently establishes that inventor You refuses to sign. Specifically, inventor You's failure to respond to the messages dated 02 March 2006 and 19 April 2006 evidence a constructive refusal to cooperate. Thus, it can be concluded with reasonable certainty that inventor You refuses to join in the application.

Inventor Shi-Ying Cai

The petition does not adequately show that a diligent effort was made to locate inventor Cai. In particular, the petition includes documentary evidence of a single attempt to reach inventor Cai via postal mail. Although copies of various documents attached to the petition suggest that other attempts were made to find inventor Cai (e.g. electronic mail, internet directories, etc.), the petition does not include an affidavit explaining such attempts. The affidavit must be signed by the person with firsthand knowledge of such attempts. Furthermore, evidence of attempts to reach inventor Cai by telephone and through his/her former employer has not been furnished. Thus, it would not be reasonable to conclude at the present time that inventor Cai cannot be found.

With regard to item (3) above, applicant has provided the requisite petition fee.

With regard to item (4) above, the petition states the last known address of inventor Cai but does not state the last known address of inventor You.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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